

REMARKS/ARGUMENTS

Reexamination and reconsideration of this Application, withdrawal of the rejection, and formal notification of the allowability of all claims as now presented are earnestly solicited in light of the attached evidence and remarks that follow. Claims 1, 3-10, 12-17, 19-26 and 28-36 are pending in the application.

The Examiner's attention is directed to copending and commonly owned U.S. Application No. 10/675,577, which contains claims that have been rejected over various combinations of the following U.S. patents (all of which are of record in the present case): U.S. Patent Nos. 5,101,839 to Jakob *et al.*; 5,265,626 to Schneider *et al.*; 6,257,243 to Muller *et al.*; and 5,379,789 to Schneider.

All claims of record stand rejected as unpatentable over U.S. Patent No. 5,129,408 to Jakob *et al.* in view of U.S. Patent No. 4,924,888 to Perfetti *et al.* The Examiner continues to rely upon the Jakob patent as disclosing a smokable material comprising tobacco and optionally including an aerosol forming material. The Examiner admits that the smokable material described in the Jakob patent does not comprise greater than about 90% tobacco. However, the Examiner now relies on the Perfetti patent as disclosing a smokable material that can be up to 90% tobacco material and which can contain glycerin allegedly in intimate contact with a processed tobacco material. The Examiner concludes that it would have been obvious to use a smokable material comprising more than 90% tobacco in the cigarette described in the Jakob patent. Applicants respectfully traverse this rejection.

As noted previously, the Jakob patent describes a smokable filler material that comprises a mixture of tobacco and a significant amount of an agglomerated matrix that is a non-tobacco material. For instance, the Jakob reference suggests mixtures of the agglomerated matrix with a tobacco material in amounts where the tobacco-containing filler material is present only up to about 75 weight percent and preferably far lower. The agglomerated matrix, however, is present up to about 80 weight percent, and preferably comprises 20 to about 60 weight percent of the material. Thus, the Jakob reference quite clearly caps the tobacco filler material at about 75% and preferably much lower.

The Examiner attempts to address this deficiency in the Jakob patent by reference to the Perfetti patent, which describes a more conventional smokable material formulation that is primarily tobacco material. Specifically, the Perfetti patent discloses that the smokable filler material preferably comprises mostly flue-cured tobacco material, optionally blended with other tobacco materials. For instance, the Perfetti patent teaches that the filler material is most desirably composed of more than about 70 weight percent flue-cured tobacco material. In one specific example noted by the Examiner, the filler material comprises 10 to 20% Oriental tobacco material and 80 to 90% of flue-cured tobacco material.

Applicants respectfully traverse the Examiner's conclusion that these two references would have made it obvious to one of ordinary skill in the art to use greater than 90% tobacco material in the cigarette of the Jakob patent. In particular, it is noted that one of ordinary skill in the art would be disinclined to make such a substitution because to do so would clearly run counter to the express purposes of the Jakob patent. The Examiner's attention is directed to column 2, wherein the Jakob patent discusses the desirable attributes that the invention described therein is intended to provide. In particular, the Jakob patent describes the desirability of providing a good tasting cigarette that provides good smoking satisfaction, relatively low mainstream gas phase yields, relatively low levels of incomplete combustion products, sustained smolder during FTC smoking conditions, and which generates low levels of sidestream tar or visible sidestream smoke (see column 2, lines 20-27). It would be quite obvious to one of ordinary skill in the art that the use of the term "relatively" in this paragraph is intended to contrast the desired cigarette with conventional cigarettes which comprise predominately tobacco as the smokable filler portion thereof. The Jakob patent specifically contrasts commercially available conventional cigarettes which burn tobacco cut filler in column 1, wherein such cigarettes are described as producing sidestream smoke having a "characteristic visible nature" that can be perceived negatively by certain individuals (column 1, lines 33-49). Accordingly, the Jakob patent itself notes that conventional cigarettes that burn primarily tobacco cut filler do not provide one of the "desirable" characteristics (i.e., low levels of visible sidestream smoke) associated with the mainly non-tobacco smokable material described in Jakob.

The Examiner's attention is directed to Example 1 of the Jakob patent, wherein a smokable filler material comprised primarily of an agglomerated matrix non-tobacco filler material is described. As noted at the end of Example 1, the cigarettes constructed in such a manner yielded very low levels of visible sidestream smoke and essentially no sidestream odor. In other words, the cigarette created according to the Jakob patent provided a sidestream smoke quite distinct from the sidestream smoke created by conventional cigarettes comprised primarily of tobacco cut filler. This is consistent with the express intent of the Jakob patent, which includes reduction of visible sidestream smoke (see column 2, lines 21-27; column 16, lines 54-59).

Despite the Jakob patent's clear mandate to provide a smokable filler material for cigarettes that provides very low amounts of visible sidestream smoke and odor, the Examiner counter-intuitively alleges that one of skill in the art would be motivated to replace the non-tobacco smokable material described in the Jakob patent with a conventional tobacco material that is more than 90% by weight of tobacco filler. Such a cigarette would be expected to share many of the sidestream smoke qualities associated with conventional cigarettes as noted in column 1 of the Jakob patent. In other words, such a cigarette would not be expected to exhibit the desirable cigarette qualities that the Jakob patent expressly intends to provide.

As relevant case law makes clear, a proposed modification of the prior art cannot render the prior art unsatisfactory for its intended purpose or change the principal of operation of the primary reference. See MPEP 2143.01; subheadings V and VI. The present rejection could be viewed as running afoul of either rule. One of ordinary skill in the art would clearly view the radical altering of the smokable filler of Jakob to include primarily tobacco material as rendering the smokable filler composition unsatisfactory for its intended purpose of providing low levels of visible sidestream smoke and odor. Further, one of ordinary skill in the art would view such a radical change in the smokable filler of Jakob as violating a basic principal of operation for which the Jakob filler material is expressly designed (i.e., production of low levels of visible sidestream smoke as compared to conventional cigarettes). For at least this reason, Applicants respectfully request reconsideration and withdrawal of this rejection.

Applicants also note that neither cited reference teaches or suggests additional critical elements of the claimed invention. For example, independent claim 1 recites that the aerosol forming material is in intimate contact with a processed tobacco material that is processed such that at least a portion of a solvent soluble portion of the tobacco material is removed therefrom and such that the processed tobacco material is a substrate for the aerosol forming material. Neither cited reference teaches or suggests the combination of aerosol forming material with a processed tobacco material in the manner claimed in claim 1. As noted previously, the Jakob patent merely suggests forming mixtures of aerosol forming materials with non-tobacco filler materials such as the agglomerated matrix filler described therein. In fact, every example in the patent that includes incorporation of an aerosol forming material shows the inclusion of such materials during processing of the agglomerated matrix filler, not a tobacco material and certainly not a processed tobacco material. Similarly, the Perfetti reference also fails to disclose such a combination of aerosol forming material and processed tobacco material. The only mention of glycerin addition at all is in Example 4, where the Perfetti patent merely mentions that a casing material contained glycerin. There is certainly no discussion in the Perfetti patent of forming intimate contact between an aerosol forming material and a processed tobacco material that is processed such that at least a portion of the solvent soluble proportion of the tobacco material is removed therefrom such that the processed tobacco material is a substrate for the aerosol forming material. There is simply no discussion of such a combination. For at least this additional reason, Applicants respectfully request reconsideration and withdrawal of the rejection of record.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

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